

REMARKS/ARGUMENTS

The Office Action dated February 25, 2005, has been received and carefully considered. In this response, claims 9 and 11 and the specification have been amended. It is believed that the amendments and following remarks place the application in immediate condition for allowance. Accordingly, favorable reconsideration of the application is respectfully requested.

I. **AMENDMENT TO THE SPECIFICATION**

Applicant has amended the specification to correct an error. In particular, the specification was amended to replace the term "execution" where "implementation" was intended. Applicant respectfully submits that the application as filed supports this correction, and that the amendment does not constitute new matter.

II. **THE OBVIOUSNESS REJECTION OF CLAIMS 9-32 and 41-50**

On page 2 of the Office Action, claims 9-32 and 41-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonell, Edwin D., Document Image Technology (1993) ("McDonell")¹. This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation

¹ Applicant respectfully submits that the copy of the McDonell reference provided by the Examiner is missing several pages. Accordingly, Applicant is unable to consider the entirety of the reference to assess its teachings and suggestions in light of the pending claims. Applicant respectfully requests that the Examiner provide a complete copy with the next action, so that Applicant may fully and properly consider and respond to the rejections.

of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Regarding independent claim 9, the Examiner asserts that "McDonell does not teach that the image-based document handling and delivery system implementation is operable on a computer (can be automated) or propose a file naming convention for imaged versions of each document or the inclusion of more examples of the information in the documents." The Examiner also asserts that "it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity that has accomplished the same result," and that "[i]t would have been obvious to one skilled in the art at the time of the invention that the method for implementing an image-based document handling and delivery system as taught by McDonell would have benefited from being made operable on a computer the resultant system being faster, easier to use and more efficient."

Applicant respectfully disagrees with the Examiner assertions. In particular, Applicant respectfully reminds the Examiner of compelling authority prohibiting "per se" rules of obviousness. *See, e.g., In re Orchiai*, 71 F.3d 1565, 1572, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995) ("reliance on per se rules of obviousness is legally incorrect"); *Ex parte Brouillet*, 2001 WL

1339914, *2 (Bd. Pat. App. & Interf. 2001) (“In the present case, unlike in *Venner*, the examiner has not provided a reference which discloses a high speed rotary power tool, let alone one which is used for cleaning glass. The examiner has merely relied upon a per se rule that providing a mechanical or automatic means to replace manual activity which has accomplished the same result is unpatentable.”)

Here, the Examiner attempts to overcome McDonell’s failure to disclose the claimed image-based document handling and delivery implementation system on a computer by asserting that the claimed systems and methods merely “replace manual activity that has accomplished the same result.” However, Applicant respectfully submits that the Examiner has not properly established that McDonell discloses each and every claim limitation, much less demonstrate that each and every claim limitation may be performed by hand.

For example, among its various limitations, claim 9 expressly recites “at least one process map for at least a portion of the image-based document handling and delivery system.” In rejecting the above limitation, the Examiner merely references a portion of McDonell that makes no mention of the claimed features, but rather discloses a generic statement relating to the identification of a new process:

Once the task force has identified a new process using imaging, you should reconfirm that your solution supports the goals defined earlier by senior management (such as improved customer service or faster product speed-to-market). The most important question -- “Why will document imaging enhance our organization’s performance?” -- can be revisited as a touchstone throughout the project. According to Michael Hammer, writing in the *Harvard Business Review*, “Companies tend to use technology to mechanize the old ways of doing business. They leave the existing processing intact and use computers simply to speed them up.”

McDonell Reference, Page 60, ¶ 2.

Applicant is perplexed at how the above excerpt can be said to teach or suggest “at least one process map for at least a portion of the image-based document handling and delivery system,” as expressly recited in claim 9. Applicant respectfully submits that merely identifying a process does not teach or suggest at least one process map for at least a portion of the image-based document handling and delivery system.

Further, claim 9 expressly requires that the various “process maps” be provided “in response” to the entity providing information about the infrastructure, the current handling and delivery system and the methodology used by the entity.” Applicant respectfully submits that the McDonell reference fails to teach or suggest any feature or functionality that provides such “process maps” in response to the entity providing information about the infrastructure, the current handling and delivery system, and the methodology used by the entity. The excerpts from McDonell that purportedly disclose such a feature -- namely, pages 26-28, 32-33, 54-61, and 175; Figures 2.1, 2.3, 2.4 and 5.6 -- fail to teach or suggest, among other things, that such process maps are provided in response to the entity providing information about the infrastructure, the current handling and delivery system, and the methodology used by the entity. Other rejections of the pending claims suffer from similar deficiencies.

Applicant also notes the Examiner’s repeated taking of Official Notice regarding claim limitations not disclosed in McDonell. For example, the Examiner alleges that “file naming conventions,” “use example documents,” “implementation on computer,” “contingency guidelines,” etc., are “old and very well known” in the context of the claimed systems and methods. Applicant traverses these rejections because there is no support in the record for the conclusion that the identified features are “old and well known.” In accordance with MPEP § 2144.03, the Examiner must cite a reference(s) in support of his position.

Applicant reminds the Examiner that Applicant has been unable to thoroughly vet the McDonell reference because the copy provided by the Examiner is missing several pages. As a result, Applicant is unable to properly analyze and assess its teachings and suggestions in the context of the pending claims, such as whether the McDonell teaches away from the claimed systems and methods, for example. Applicant respectfully requests that the Examiner provide a complete copy of the McDonell reference with the next action. *See, e.g.*, MPEP §2141.02 (A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention); *see also* W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Independent claims 11, 15, 24, 41 and 43 should be allowable at least for the reasons set forth above, or similar thereto.

Claims 10, 12-14, 16-23, 25-33, 42, and 44-50 are dependent upon independent claim 9, 11, 15, 24, 41 or 43. Thus, since independent claims 9, 11, 15, 24, 41 and 43 should be allowable as discussed above, claims 10, 12-14, 16-23, 25-33, 42, and 44-50 should also be allowable at least by virtue of their dependency on independent claim 9, 11, 15, 24, 41 or 43. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 9-32 and 41-50 be withdrawn.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed

telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

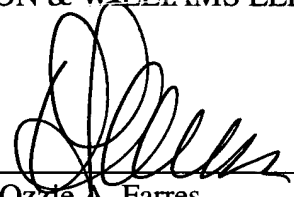
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Respectfully submitted,

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